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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/681,354

10/09/2003

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Q77902

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EXAMINER

KENNY, DANIEL J

ART UNIT

PAPER NUMBER

3633

NOTIFICATION DATE

DELIVERY MODE

01/23/2012

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PIERO CRETTI

Appeal 2012-002604
Application 10/681,354
Patent US 6,298,622 B1
Technology Center 3600

Before LINDA E. HORNER, KEN B. BARRETT, and
MICHAEL C. ASTORINO, *Administrative Patent Judges*.

HORNER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Piero Cretti (Appellant) seeks our review under 35 U.S.C. § 134 of the Examiner's decision rejecting claim 90 in reissue application 10/681,354. The Examiner rejected claim 90 under 35 U.S.C. § 251 as based on a defective reissue declaration because claim 90 was added in an amendment

filed outside the two-year broadening window. This reissue application seeks to reissue U.S. Patent 6,298,622 B1, issued October 9, 2001, based on Application 09/425,165, filed October 22, 1999. The Examiner withdrew all rejections of claim 1-89. Ans. 4-5.¹ We have jurisdiction under 35 U.S.C. § 6(b). We REVERSE.

THE INVENTION

Appellant's claimed invention "relates, in a general aspect thereof, to a self-supporting construction element of expanded plastics material, in particular for manufacturing floor elements and walls of buildings in general." '622 Patent, col. 1, ll. 13-16. Claim 90 is reproduced below.

90. A construction assembly comprising:
- a plurality of elements of expanded plastics arranged side-by-side, said element including:
 - a) a central body, substantially parallelepipedic in shape, provided with opposite upper and lower faces and with opposite lateral sides;
 - b) at least one reinforcing section bar embedded in the expanded plastics;
 - c) a sheet-like member for supporting at least one layer of a suitable covering material, said sheet-like member being associated to a fin of said reinforcing section bar;
 - a concrete casting housed in a cavity defined between said opposite lateral sides of adjacent element of said plurality of elements of expanded plastics; and
 - means for stably anchoring the sheet-like member to said concrete casting.

¹ The Examiner stated that "only claim 90 is rejected under 35 U.S.C. § 251" and that "[t]he indication of claims 1-90 as rejected was a typographical error" and "the rejection of claims 1-89 under 35 U.S.C. § 251 is being withdrawn given the Federal Circuit's decision in *In re Tanaka*." Ans. 4-5.

CONTENTIONS AND ISSUE

The Examiner finds that the original reissue application declaration shows Appellant's intention "to get coverage (in new independent claims 66 and 75) on the unclaimed rigid covering element, the rigid covering element already covered by the claimed generic 'sheet-like member' of independent claims 27 and 42, respectively." Ans. 6. Thus, the Examiner's position is that Appellant's intention indicated in the original reissue declaration was not to broaden the claims, but to claim in the reissue an unclaimed species which was already encompassed by the patented claims. *Id.*

Appellant acknowledges that "[t]he key inquiry is whether the original reissue application was a broadening reissue." Br. 13. Appellant argues that the original reissue application "provided the required notice to the public that Applicant intended to broaden the claims." Br. 14 (citing portions of original reissue declaration in which Appellant characterized the newly-added reissue claims as providing protection for an alternative embodiment having a rigid covering element that was not covered by the '622 patent). Appellant also argues that "the unequivocal intent to broaden in the original reissue declaration was previously acknowledged by the Examiner in the March 27, 2009 Supplemental Office Action" in which "the Examiner rejected claims 66-89 under 35 U.S.C. § 251 as 'being broadened in a reissue application.'" Br. 15.

The issue presented by this appeal is:

Did Appellant unequivocally indicate in the reissue application an intention to broaden within two years from the grant of the original patent?

FINDINGS OF FACT

We find that the following enumerated findings are supported by at least a preponderance of the evidence.

1. Appellant filed reissue application 10/681,354 on October 9, 2003, seeking to add reissue claims 66-89 to U.S. Patent 6,298,622, issued October 9, 2001. Preliminary Amendment dated October 9, 2003.
2. Appellant concurrently filed a Reissue Application Declaration By the Inventor (“Original Reissue Decl.”), which stated: “I verily believe the original patent to be wholly or partly inoperative or invalid . . . by reason of the patentee claiming more or less than he had the right to claim in the patent.” Original Reissue Decl. at 1.
3. Appellant further described that after grant of the ‘622 patent:

[T]he inventor realized that the claims of U.S. Patent 6,298,622 recited features which limited the scope of protection to an extent narrower than was previously assumed without having a full knowledge of the self-supporting construction elements which could be marketed in the U.S..

In this particular market, in fact, the current industrial practice requires that the expanded plastics material be finished with a rigid covering element rather than a sheet-like member for supporting at least one layer of a suitable covering material as it happens in the European market.

A deeper analysis of the matter reveled that, notwithstanding what the inventor had understood the patent claims were drafted from the outset, that is, in the original Italian application, in such a way that an alternative embodiment of the self-supporting construction element and of the construction assembly of the invention, in which the sheet-like member for supporting at least one layer of a suitable covering material was replaced by a rigid covering element,

was not covered even though it was clearly described in the specification.

The primary error with respect to U.S. Patent 6,298,622, which has the object of devising self-supporting construction elements of expanded plastics material and construction assemblies including the same capable of improving their resistance to fire and to aging phenomena, resides in the fact that each of independent claims 27, 42 and 55 is unduly limited in view of the prior art and fails to provide a protection for the aforementioned alternative embodiment of the invention as disclosed in the patent.

It has in fact be determined that the aforementioned object may be achieved in a new and unobvious way by a self-supporting construction element and by a construction assembly which do not necessarily include the sheet-like member for supporting at least one layer of a suitable covering material as currently recited in granted claims 27, 42 and 55, but which include, instead, a rigid covering element as was clearly described in the patent.

Original Reissue Decl. at 2.

4. The Examiner rejected reissue claims 66-89 as violating the rule against recapture based on the determination that the claims are broader in scope than the original claims. Supplemental Office Action dated Mar. 27, 2009 at 4-5.
5. Appellant argued that reissue claim 66 is not missing the claim limitation identified by the Examiner when compared to patent claim 27 and that the only difference between reissue claims 75 and 84, and patent claims 42 and 55, respectively, is the substitution of a rigid covering element for the sheet-like member. Response to Office Action dated Aug. 24, 2009 at 19, 21-24. As to this difference, Appellant argued that “the rigid covering element can be considered a

- species of the genus ‘sheet-like member’ since the claimed rigid covering element is still adapted to support a suitable covering material such as a layer of plaster.” *Id.* at 22, 24. Thus, Appellant asserted that claims 75 and 84 may be “interpreted to have a scope which is narrower than or at best equal to that of granted claim[s 42 and 55, respectively], as far as this aspect is concerned.” *Id.*²
6. The Examiner withdrew the recapture rejection and rejected claims 1-89 under 35 U.S.C. § 251 based upon a defective reissue declaration because the reissue application added only claims that were narrower than the patent claims without either narrowing a broader patent claim by amendment or canceling a broader patent claim. Thus the Examiner determined that the reissue application did not present an error correctible by reissue. Second Office Action dated Oct. 27, 2009 at 2-3 (citing MPEP § 1402).
 7. In response to the Second Office Action, Appellant amended the claims to add new reissue claim 90 and submitted a Supplemental Reissue Declaration identifying the error as claiming less than Appellant had a right to claim in the patent. Response to Second Office Action dated Feb. 26, 2010 at 20 (stating that “new claim 90 is broader than issued claim 42”).
 8. The Examiner then rejected claims 1-90³ under 35 U.S.C. § 251, fourth paragraph, as defective because the reissue application is a

² Reissue claim 66 also replaces the “sheet-like member” limitation of patent claim 27 with a “rigid covering element.”

³ In the Answer the Examiner clarified that inclusion of claims 1-89 was a typographical error. Ans. 3.

- broadening reissue filed outside the two year statutory period. Third Office Action dated Apr. 13, 2010 at 2.⁴
9. Appellant then timely appealed the Examiner's decision to this Board. Notice of Appeal dated Oct. 13, 2010.
 10. Reissue claims 66, 75, and 84 differ from patented claims 27, 42, and 55, respectively, in the substitution of "a rigid covering element" for "a sheet-like member for supporting at least one layer of a suitable covering material." *Id.* at 20, 21, 23 (showing claim charts comparing reissue claims 66, 75, and 84 to patented claims 27, 42, and 55).⁵
 11. The Specification describes three embodiments of the invention. A first embodiment is a construction element for constructing floors having a single lath for supporting at least one covering layer. '622 patent, col. 4, ll. 45-46; col. 7, ll. 1-2; col. 8, ll. 34-37; figs. 1 and 2. A second embodiment is a wall element having a pair of laths each adapted to support a respective covering layer. '622 patent, col. 4, ll. 61-64; col. 9, ll. 37-40; fig. 3. A third embodiment is a wall element having "instead of the second lath for supporting the covering

⁴ The third Office Action does not repeat the rejection of claims 1-89 under 35 U.S.C. § 251 as failing to present an error correctible by reissue. It appears, however, that this rejection was outstanding at the time of appeal; and the Examiner withdrew the rejection in the Answer. Ans. 3.

⁵ "A claim in the reissue which includes subject matter not covered by the patent claims enlarges the scope of the patent claims. For example, if any amended or newly added claim in the reissue contains within its scope any conceivable product or process which would not have infringed the patent, then that reissue claim would be broader than the patent claims." MPEP § 1412.03(I) (citing *Tillotson, Ltd. v. Walbro Corp.*, 831 F.2d 1033, 1037 n.2 (Fed. Cir. 1987); *In re Ruth*, 278 F.2d 729, 730 (CCPA 1960); *In re Rogoff*, 261 F.2d 601, 603 (CCPA 1958)).

- layer—a rigid covering element associated to the reinforcing section bar on the face opposite to that having the first lath.” ‘622 patent, col. 5, ll. 3-7; fig. 4. *See also* ‘622 patent, col. 9, ll. 41-45 (describing the rigid covering element as “a panel 22 of gypsum paperboard, wood, rigid plastics, or another suitable material for decorative and/or structural purposes.”).
12. Figure 4 shows the rigid covering element as a sheet-like panel 22.
13. The Specification describes:
- In the following description and the subsequent claims, the terms: lath for supporting at least one covering layer, encompass not only conventional mesh — either smooth or provided with protruding ribs — obtained by stretching a suitably notched metal sheet, but also any sheet-like member adapted to support a suitable covering material.
- ‘622 patent, col. 2, ll. 20-25.
14. Thus, the Specification defines “lath for supporting at least one covering layer” as meaning “any sheet-like member adapted to support a suitable covering material.”
15. The Specification distinguishes between a “lath” and a “rigid covering element.” In particular, in the third embodiment, the “lath” or “sheet-like member” for supporting at least one covering layer is replaced with “a rigid covering element” thereby eliminating the lath or sheet-like member for supporting at least one covering layer altogether.
16. An ordinary meaning of “sheet” is “a broad, relatively thin, usually rectangular mass or piece of material, such as paper, metal, glass, or plywood.” THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH

LANGUAGE (2007), available at <http://www.credoreference.com/entry/hmdictenglang/sheet1>.

PRINCIPLES OF LAW

35 U.S.C. § 251, fourth paragraph, provides, “No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.”

The court in *In re Fotland*, 779 F.2d 31, 34 (Fed. Cir. 1985) held that a “no defect” reissue application filed within two years of the patent grant that did not assert broadened claims or allege a defect in the patent within two years from the date of grant of the original patent could not be relied upon to later file the requisite declaration and broadened claims outside the two year window. The court subsequently held that “the reissue statute requires that proposals to broaden a patented invention must be brought to public notice within two years of patent issuance.” *In re Graff*, 111 F.3d 874, 877 (Fed. Cir. 1997) (distinguishing *In re Doll*, 419 F.2d 925 (CCPA 1970) which “simply held that the reissue applicant, in the course of prosecution of the reissued application, was not barred from making further broadening changes in the claims” when the public was placed on notice of the patentee’s intention to enlarge the claims within the two year statutory period). The court in *Graff* relied on *Fotland* to support its interpretation of 35 U.S.C. § 251, fourth paragraph. *Id.* The court in *Graff* stated that “[t]he reissue statute balances the purpose of providing the patentee with an opportunity to correct errors of inadequate claim scope, with the public interest in finality and certainty of patent rights.” *Id.* (citation omitted).

ANALYSIS

Appellant argues that the Examiner erred in rejecting reissue claim 90 because under the holding in *Doll*, Appellant should be allowed to add a broadened claim outside the two year window because he put the public on notice of his intention to broaden the claims in the original reissue declaration, filed exactly two years from the date of the patent grant.⁶ The Examiner's position is that the holding in *Graff* applies to this case because Appellant did not put the public on notice of his intention to broaden the claims until the filing of new claim 90 and the accompanying Supplemental Reissue Declaration more than two years from the date of the patent grant.

During prosecution of the reissue application, Appellant inconsistently characterized the reissue claims 66-89 as both broadening and narrowing the subject matter covered by the patented claims (Facts 2, 3, 5). Likewise, the Examiner took inconsistent positions as to whether claims 66-89 are broadening or narrowing (Facts 4, 6, 8). We decline in this case to rely simply on Appellant's characterizations of the scope of the reissue claims in the Original Reissue Declaration to determine what the public would have understood to be Appellant's intention at the time of filing the reissue application. We find, based on the wording of reissue claims 66-89 and based on statements made in the Original Reissue Declaration both filed concurrently within the two year window, that at the time of filing of the reissue application, Appellant put the public on notice of his intention to present new reissue claims that replaced "a sheet-like member for supporting

⁶ "A reissue application filed on the 2-year anniversary date from the patent grant is considered to be filed within 2 years of the patent grant." MPEP § 1412.03(IV).

at least one layer of a suitable covering material” with “a rigid covering element” (Facts 3, 10). In light of this clear intention, we decide whether in fact reissue claims 66-89 are broader or narrower than the original patented claims, so as to determine whether the public was put on notice of an intention to broaden the patent claims within the two year window.

While in some instances a “rigid covering element” such as a panel of gypsum paperboard might be “sheet-like” in form, in other instances a rigid covering element may not necessarily take the form of a “sheet-like member” (Fact 16). The third embodiment of the Specification replaces the lath, or sheet-like member, with a rigid covering element and thus distinguishes between a lath or sheet-like member for supporting a covering layer and a rigid covering element (Facts 11, 13-15). While the rigid covering element is depicted in Figure 4 as a sheet-like panel 22 (Fact 12), the claimed “rigid covering element” is not limited to the preferred embodiment, and the Specification describes that the rigid covering element can include “wood, rigid plastics, or another suitable material for decorative and/or structural purposes” (Fact 11). Thus, under a broadest reasonable interpretation, a “rigid covering element” may be “sheet-like” or may be comprised of rigid material of a non-sheet-like configuration. For example, the rigid covering element could include a rigid plastic molded or formed to a shape that is not relatively thin or “sheet-like.” Alternatively, the rigid covering element could include wooden 2x4s that are not relatively thin or “sheet-like.” As such, independent reissue claims 66, 75, and 84, are broader than original patent claims 27, 45, and 55, respectively, in the aspect of the “rigid covering element” in that these new reissue claims would read

on a construction element having a rigid covering element that is not in the form of a “sheet-like” structure. In other words, reissue claims 66, 75, and 84 contain within their scope a product which would not have infringed the patent, and these reissue claims are thus broader than the patent claims in this aspect. Appellant’s presentation of reissue claims 66, 75, and 84, in combination with the filing of the Original Reissue Declaration describing this amendment to the claim scope, within the two year window adequately put the public on notice of Appellant’s unequivocal intention to broaden the patent claims by reissue. As such, under the holding in *Doll*, Appellant is permitted to add broadened claim 90 outside the two year window. For these reasons, we do not sustain the Examiner’s rejection of claim 90 under 35 U.S.C. § 251, fourth paragraph.

CONCLUSION

Appellant unequivocally indicated in the reissue application an intention to broaden within two years from the grant of the original patent.

DECISION

The decision of the Examiner to reject claim 90 is REVERSED.

REVERSED

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